

**REMARKS**

The present application relates to hybrid maize plant and seed 34M94. Claims 5-8, 20, 33, and 42-63 have been canceled. Claims 63-90 has been added. No new matter has been added by the present amendment. Applicant respectfully requests consideration of the following remarks.

**Detailed Action*****A. Claim Objections***

Applicant acknowledges the objection of claims 51 and 53 under 37 C.F.R. § 1.75, as being duplicate claims of 20 and 33. Applicant has canceled claims 20, 33, 51 and 53, thus rendering this objection moot.

Applicant further acknowledges the objection of claims 43-45 and 48-50 under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Although not acceding to the Examiner's objection, Applicant has canceled claims 43-45 and 48-50, thereby rendering this objection moot.

***B. Newly Submitted Claims***

Applicant acknowledges the addition of new claims 63 through 90 as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim submitted by Supervisory Patent Examiner Amy Nelson via e-mail on August 7, 2003 and revised via telephone on August 25, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification. Support for the specific items noted in the claims faxed by Examiner Fox can be found within the specification for *Bacillus thuringiensis* on page 46; for imidazolinone, sulfonylurea, glyphosate, glufosinate, L-phosphinothricin, triazine, and benzonitrile on pages 48-49; for phytase on page 49; and for stearyl-ACP desaturase, fructosyltransferase, levansucrase, alpha-amylase, invertase and starch branching enzyme on pages 49-50.

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claim 8 remains and claims 46-50 and 61 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Although not acceding to the Examiner's rejection, in order to expedite prosecution Applicant has canceled claim 8, thereby rendering this rejection moot.

Claim 46 stands rejected as indefinite for the terminology "a transgenic 34M94 hybrid" as the Examiner states it is unclear what the metes and bounds of the claimed methods are.

Applicant has now canceled claim 46, thus alleviating this rejection.

The Examiner rejects claim 49 for the recitation "derivative thereof or a synthetic polypeptide modeled thereto" rendering the claim indefinite.

Applicant has canceled claims 49, thereby alleviating this rejection.

Claim 61 stands rejected as indefinite for the recitation "utilizing".

Applicant has canceled claim 61, alleviating this rejection.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 46-50, 55, and 56 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record stated in the Office Action mailed December 27, 2002.

Although not acceding to the Examiner's rejection, to expedite prosecution Applicant has canceled claims 5-8, 20, 33, and 42-63, thereby rendering this rejection moot. Applicant has added new claims 63-90 as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim submitted by Supervisory Patent Examiner Amy Nelson via e-mail on August 7, 2003 and revised via telephone on August 25, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification as described *supra*.

Claims 8, 42-44, and 57-62 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record in the Office Action mailed December 27, 2002.

Applicant traverses this rejection. Nevertheless, in order to expedite prosecution claims 8, 42-44, and 57-62 have been canceled and new claims 63-90 have been added as disclosed *supra*. Applicant requests reconsideration.

Claims 8, 42-44, 46-50, and 55-62 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains or with which it is most nearly connected, to make and/or use the invention.

Applicant respectfully traverses this rejection. Applicant submits that the actual ATCC deposit will be delayed until receipt of notice that the application is otherwise in condition for allowance. As provided in 37 C.F.R. §§ 1.801-1.809, Applicant wishes to reiterate they will refrain from deposit of hybrid maize plant 34M94 and the inbred parents GE568044 and GE533486 until allowable subject matter is indicated. Once such notice is received, an ATCC deposit will be made, and the specification will be amended to contain the accession number of the deposit, the date of the deposit, description of the deposited biological materials sufficient to specifically identify and to permit examination and the name and address of the depository. The claims will also be amended to recite the proper ATCC deposit numbers. The Applicant provides assurance that:

- a) during the pendency of this application access to the invention will be afforded to the Commissioner upon request;
- b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- c) the deposit will be maintained in a public depository for a period of thirty years, or five years after the last request for the enforceable life of the patent, whichever is longer;
- d) a test of the viability of the biological material at the time of deposit will be conducted (see 37 C.F.R. § 1.807); and

e) the deposit will be replaced if it should ever become inviable.

Therefore, Applicant submits at least 2500 seeds of hybrid maize plant 34M94 and the inbred parents GE568044 and GE533486 will be deposited with the ATCC. Nevertheless, in order to expedite prosecution claims 8, 42-44, 46-50, and 55-62 have been canceled and new claims 63-90, have been added as disclosed *supra*.

In addition, Applicant asserts that the introgression of mutant genes and transgenes is easily, routinely and extensively practiced by those of ordinary skill in the art. Backcrossing has been known since the 1920's and, because of its predictability, is the method preferred by commercial plant breeders to introduce transgenes into already developed and tested material. An example of how one of ordinary skill in the art can transfer a gene conferring a qualitative trait into a variety through backcrossing is demonstrated by the fact that the commercial market now distributes a multitude of products produced in this manner. Such conversion lines are easily developed without undue experimentation.

Further, the Applicant would like to reiterate that a patent application "need not teach, and preferably omits, what is well known in the art." *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F.2d 1367, 231 U.S.P.Q. 81 (Fed. Cir. 1986); MPEP § 601.

In light of the above amendments and remarks, Applicant respectfully requests reconsideration and withdrawal of the rejections to claims 8, 42-44, 46-50, 55-62 under 35 U.S.C. § 112, first paragraph.

### Summary

Applicant acknowledges that claims 1-7, 20, 33, 52, and 54 are allowed.

Applicant has amended the claims as suggested by Examiner David Fox and Supervisory Patent Examiner Amy Nelson as allowable. Applicant submits the claims place the application in condition for allowance and comply with all requirements of form set forth in previous office actions.

### Conclusion

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested.

If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



LILA A. T. AKRAD, Reg. No. 52,550  
McKEE, VOORHEES & SEASE, P.L.C.  
801 Grand Avenue, Suite 3200  
Des Moines, Iowa 50309-2721  
Phone No: (515) 288-3667  
Fax No: (515) 288-1338  
**CUSTOMER NO: 27142**

Attorneys of Record

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